

REMARKS

Claims 1-12 and 15-19, 21-24 and 31-33 were previously pending in the application. By the Amendment, new Claims 34 - 36 have been added, and Claims 1-12 and 15-19, 21-24 and 31-33 remain unchanged.

The claims stand rejected under the cited prior art of record. Specifically, Claims 1-10, 15-19, 21-23 and 31-33 are rejected under 35 U.S. 103(a) as being unpatentable over Young et al. (US 4,444,821) in view of Schmidberger (DE 1,004,207) and Hord, Jr. (US 3,771,816).

Independent Claim 1 recites a heat insulated wall, comprising a connecting profile, *an evacuable heat insulating material*, two outer covering layers having contours and disposed at a distance from one another, said two outer covering layers connected to said connecting profile running along said contours with a *vacuum-tight seal*, said two outer covering layers together with said connecting profile enclosing an *air evacuated intermediate space* forming a vacuum within the heat insulated wall and said evacuable heat insulating material being disposed within the intermediate space, at least one of said two outer covering layers having an aperture formed therein, a tube section including two end sections, at least one of said two *end sections having a circumferentially positioned flange-shaped expanded and flattened region*; and said at least one flange-shaped expanded and flattened region having an end surface facing away from said tube section and being welded to said at least one of said two outer covering layers at said aperture with a vacuum-tight seal, wherein a *circular weld seam is formed around said aperture* to connect at least one of said two outer covering layers to said flange-shaped expanded and flattened region. None of the cited references, either alone or in combination, teach a heat insulated wall having a tube section with *end sections having a circumferentially positioned flange-shaped expanded and flattened region* being welded to an outer covering layer at an aperture with a *vacuum tight seal*, wherein a *circular weld seam* is formed around the *aperture* to connect the outer covering layer to the flange-shaped expanded and flattened region.

It is well settled that almost all claimed inventions are but novel combinations of old features. The courts have held in this context, however, that when "it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation *in the prior art* to make the selection made by the applicant".

Interconnect Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985) (emphasis added). “Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination”. In re Bond, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). “Under Section 103 teachings of references can be combined *only* if there is some suggestion or incentive to do so.” ACS Hospital Systems, Inc. v. Montefiore Hospital et al., 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original). “Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be ‘*clear and particular*.’” Winner Int’l Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587, 202 F.3d 1340 (Fed. Cir. 2000) (emphasis added; citations omitted); Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 56 USPQ2d 1456, 1459 (Fed. Cir. Oct. 17, 2000).

In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the applicants’ disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988), *cert. den.*, 488 U.S. 825 (1988).

Applicant respectfully believes that any teaching, suggestion, or incentive possibly derived from the Schmidberger and Hord, Jr. references or the other cited art is only present with *hindsight* judgment in view of the instant application. “It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant’s structure as a template and selecting elements from references to fill the gaps. . . . The references *themselves* must provide some teaching whereby the applicant’s combination would have been obvious.” In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in the cited references. In fact, no support, justification, rationale, or reason is given to make such a conclusion.

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453,1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, *identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention*. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125,1127 (Fed. Cir. 1984).

In the present case, Schmidberger discloses a refrigerator housing having two walls (10,12). A spacing piece (30) is connected to the walls (10,12). In Schmidberger, the walls (10,12) and spacing piece (30) are made from a thermoplastic material. Hord, Jr. discloses a kingpin assembly in a *trailer frame*. The lower end of the kingpin (6) extends to an aperture in a base frame plate (4). The kingpin (6) includes a lip located near the *center* of the kingpin (6) which is welded to the base frame plate by a circular weld (12), as shown in FIG. 2. There is no motivation, suggestion or teaching of the desirability of combining a references related to a kingpin assembly in a *trailer frame* (Hord, Jr.) with a reference related to a refrigerator housing having two walls made of thermoplastic (Schmidberger) in order to make the specific combination which is taught by the present invention.

Furthermore, even if Schmidberger and Hord, Jr. were combined, these references would not result in the present invention since the combination would lack certain claimed elements. Fore example, while Schmidberger discloses that the tubular spacers 30 are welded to the walls 10 and 12 by means of flanges, there is no teaching or suggestion that a *flange-shaped expanded and flattened region* is welded to an outer covering layer at an aperture with a *vacuum tight seal*, as required by the present invention. In fact, it would be impractical to form a *vacuum tight seal* in the refrigerator housing taught by Schmidberger, since the walls (10,12) and spacing piece (30) are made from a thermoplastic material and would have difficulty retaining their shape and their insulative properties, once a *vacuum tight seal* was please between them.

Moreover, Hord, Jr. does not disclose a tube section which includes two end sections, at least one of said two *end sections having a circumferentially positioned flange-shaped expanded*

and flattened region, as recited in claim 1. Furthermore, the kingpin (6) taught by Hord, Jr. is welded to the base frame plate (4) using *solder*, as illustrated in FIG. 2, and not using a *beam welding process* as recited in claim 32. The weld disclosed in Hord, Jr. uses solder, and not beam welding, since the weld in Hord, Jr. is primarily designed for strength and beam welding would not necessarily provide the weld in Hord, Jr. with the appropriate strength. Moreover, the lip of the kingpin (6) is welded along an edge of the lip to the base frame plate (4), and not between an edge of said flange-shaped expanded and flattened region and said tube section, as recited in new claim 36. Therefore, even if Hord, Jr. were combined with Schmidberger, they still would not teach or suggest all of the limitations required in the claimed invention.

Additionally, According to MPEP Section 2141.01(a), "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be *in the field of applicant's endeavor* or, if not, then be *reasonably pertinent to the particular problem* with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

The kingpin assembly taught in Hord, Jr. is not an *analogous art* in that it is not in the *field of Applicant's endeavor* and is not at all *pertinent to the particular problem* which is being solved, which is, attaching a tube with a flange to an outer covering layer of a heated insulated wall, *without* having to *perfectly align* the tube section with an *aperture* formed in at least one of said two outer covering layers. The fact that the kingpin (6) actually extends through an opening in the base frame plate (4), illustrated in FIG. 2, indicates that there to be a more precise alignment between the kingpin (6) and the opening in the base frame plate (4), which is not required in the present invention.

For these and other reasons, Applicants maintain that the cited references, either along or in combination, do not teach or suggest the subject matter defined by the claims.

CONCLUSION

In view of the above, entry of the present Amendment and allowance of Claims 1-12, 15-19, 21 - 24 and 31-36 are respectfully requested. If the Examiner has any questions regarding this amendment, the Examiner is requested to contact the undersigned. If an extension of time for this paper is required, petition for extension is herewith made.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Craig J. Loest", with a stylized flourish at the end.

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